

**REMARKS**

Entry of the foregoing and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments which follow.

As correctly noted in the Office Action Summary, claims 5, 39, 63 and 64 were pending. By the present response, claim 39 has been amended. Thus, upon entry of the present response, claims 5, 39, 63 and 64 remain pending and await further consideration on the merits.

Support for the foregoing amendments can be found, for example, in at least the following locations in the original disclosure: the original claims.

Entry of the foregoing is appropriate pursuant to 37 C.F.R. §1.116 for at least the following reasons. First, the amendments address the new grounds of rejection under 35 U.S.C. §102(b), thereby reducing the number of issues present upon appeal. Second, the amendments raise no new issues that would necessitate further search and/or substantive reexamination. Third, the amendments clearly overcome the grounds of rejection.

***CLAIM REJECTIONS UNDER 35 U.S.C. §102***

Claims 5, 39, 63 and 64 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,678,813 to Osako et al. (hereafter "*Osako et al.*") on the grounds set forth in paragraph 3 of the Official Action. For at least the reasons noted below, this rejection should be withdrawn.

To anticipate a claim, the reference must teach every element of the claim. See MPEP § 2131. Here, the rejection is traversed because the cited reference

does not teach every element of the claim. The following comments on the reference are offered.

*Osaka et al.* discloses a book binding method that produces saddle-stitched bound books. The disclosed method includes sequentially feeding body signatures from a plurality of body signature feeders to a conveying means disposed in parallel and below the body signature feeders (col. 4, lines 10-14). The body signatures are stacked on the conveying means and back-saddle-stitched from below (col. 4, lines 14-16). As described with reference to the apparatus in Fig. 8, *Osaka et al.* discloses that an apparatus for carrying out the disclosed bookbinding method has stitching members 114a that travel back and forth by a constant stroke at the same speed and in the same direction as the conveying chain mechanism 111 to saddle-stitch the back of the gathered body signatures 301 (col. 9, lines 4-7).

Independent claim 5 recites that an apparatus for stacking sheets of printing media, said sheets having folds therein, comprises, amongst other features, a stapler assembly translatable transversely across a paper path of the apparatus.

Comparing the disclosure in *Osaka et al.* to the claims of the present application at issue here, the *Osaka et al.* patent does not disclose at least "a stapler assembly translatable transversely across a paper path." Rather, and in direct contrast to claim 5, the stitching members 114a in *Osaka et al.* (identified by the Examiner as a translatable stapler assembly) travel back and forth by a constant stroke at the same speed and in the same direction as the conveying chain mechanism 111, i.e., in the same direction as the paper path. In light of at least this difference, Applicant respectfully submits that an anticipatory rejection is improper since *Osaka et al.* does not disclose the invention as claimed. Accordingly,

withdrawal of the rejection of independent claim 5 and dependent claim 64 is respectfully requested.

Independent claim 39 recites that a method apparatus for stacking sheets of printing media comprises, amongst other features, translating a stapler assembly transversely across a paper path to staple the sheets in the stack together.

Comparing the disclosure in *Osaka et al.* to the claims of the present application at issue here, the *Osaka et al.* patent does not disclose a method that includes "translating a stapler assembly transversely across a paper path to staple the sheets in the stack together." Rather, and in direct contrast to claim 39, the stitching members 114a in *Osaka et al.* (identified by the Examiner as a translatable stapler assembly) travel back and forth by a constant stroke at the same speed and in the same direction as the conveying chain mechanism 111, i.e., in the same direction as the paper path. In light of at least this difference, Applicant respectfully submits that an anticipatory rejection is improper since *Osaka et al.* does not disclose the invention as claimed. Accordingly, withdrawal of the rejection of independent claim 39 and dependent claim 63 is respectfully requested.

Further and with respect to claim 63, Applicant notes that the claimed stapler assembly that includes a stack justifier pin is not disclosed in *Osaka et al.* Rather, *Osaka et al.* discloses a pusher mechanism 112, which differs from a stack justifier pin. Even if one considers the pusher mechanism 112 of *Osaka et al.* as a stack justifier pin, the pusher mechanism 112 of *Osaka et al.* is on the conveying chain mechanism 111 and is not associated with a stapler assembly as claimed. Based on the above, it is respectfully asserted that the disclosure in *Osaka et al.* does not

include all of the features of claim 63. For at least this further reason, withdrawal of the rejection of claim 63 is respectfully requested.

**CONCLUSION**

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

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